

Remarks/Arguments

Claims 1-10 have been cancelled. New Claims 11-17 are set forth as replacements for cancelled Claims 1-10.

The Examiner has rejected Claims 1-10 (now Claims 11-17) under the judicially created doctrine of obviousness-type double patenting as being unpatentable over:

- (a) Claim 1-5 of U.S. Patent No. 6,436,887;
- (b) Claims 1-10 of U.S. Patent No. 6,495,499; and
- (c) Claims 1-10 of copending application No. 09926673.

The enclosed Terminal Disclaimers to U.S. Patent Nos. 6,436,887 and 6,495,499 and copending application No. 09920673 overcome these rejections.

The Examiner has rejected Claims 1, 3-8 under 35 U.S.C. 103(a) as being unpatentable over Blanvalet et al (U.S. 5,380,452) in view of Lloyd et al (U.S. 4,600,620) or Smith III et al (U.S. 5,914,177) and Claims 2, 9 and 10 under U.S.C. 103(a) as being unpatentable over Blanvalet et al (U.S. 5,380,452) in view of Lloyd et al (U.S. 4,600,620) or Smith III et al (U.S. 5,914,177) in further view of Shantz et al (U.S. 20010055609).

The subject matter of original Claims 2, 9 and 10 has been incorporated into new Claim 11. These rejections are not valid for the following reasons.

This 35 U.S.C. 103 rejection of the Examiner is grounded in pure hindsight. The mandate in 1993 of 35 U.S.C. 103 clearly requires that the references at least minimally suggest the combination of references to solve the problem as solved by the instant invention. Where does any of the reference suggest the formation of a cleaning wipe containing the claimed preservative system? 35 U.S.C. 103 requires the references suggest the combination. The Examiner's attention is drawn to:

1. In Heckle Corp. vs. Coral, Inc. (DC NJLL 12/28/90), 21 USPQ 2d 1081, the Court said:

"Obviousness is not determined by ability of infringer to reconstruct invention from prior art, lone after it had copies patent and not prior art.

Mere fact that individual elements of invention are old and can be found in prior art is irrelevant in determining whether challenger has proven that combined prior art rendered patent obvious.

Defendant's attempt to establish obviousness based not only on multiple references but also on presuppositions that person of ordinary skill would necessarily pick and choose among multitude of disclosures to combine them exactly as did inventor is insufficient to meet its burden of proof."

2. In Pentech International Inc. vs. Hayaduchok (DC SNY 11/12/90), 21 USPQ 2d 1337, the Court said:

"Combination of prior art features which represents the improvement over prior combinations will not be deemed obvious unless there is some teaching or suggestion in prior art that combination be made; fact that inventor may have arrived at combination by process of elimination, by testing and rejecting combinations that would not work in desired way, is not necessarily ground for invalidation of patent."

The challenge of the Examiner is whether any of her references suggest the combination. The answer to the challenge is no and therefore, according to Pentech International, Inc. case, the claims are allowable. Moreover, it is submitted that the combination of references proposed by the Examiner is an application of hindsight using the applicant's disclosure as the basis for combination. The Court of Appeals has rejected this approach on numerous occasions.

In ASC Hospital Systems, Inc. vs. Montefiore Hospital, 732 F.2d 1572, 221 U.S.P.Q. 929 (Fed. Cir., 1984) the court states:

"To properly combine the references to reach the conclusion that the subject matter...would have been obvious, case law requires that there must have been some teaching, suggestion, or inference in either reference, or both, or knowledge generally available to one of ordinary skill in the art to combine the relevant teachings of the reference." 221 U.S.P.Q. at 933.

The references, viewed by themselves and not in retrospect, must suggest doing what applicant has done. In re Shaffer, 229 F.2d 476, 108 U.S.P.Q. 326 (C.C.P.A., 1956).

The Examiner is also referred to:

"Prior art reference that gives only general guidance and is not at all specific as to particular form of claimed invention and how to achieve it may make certain approach "obvious to try" but does not make invention obvious." Obukowicz, Ex parte (Bd Pat App & Inter, 10/30/92) 1063

The Examiner's contention appears to be that there is no requirement that a motivation to make the modification be expressly articulated. This reasoning is completely without basis in the law. This concept is in error. The Examiner is referred in particular to the August 6, 1993 decision of the Board of Patent Appeals and Interferences in Ex parte Levengood, Bd Pat App & Inter 8/6/93, p.1300, wherein the Board again restated the requirements that an Examiner must use in combining references to maintain a valid and proper 35 U.S.C. 103. The Board in Ex parte Levengood stated that: "Examiner cannot establish obviousness through references describing various aspects of applicants invention unless Examiner also provides evidence of motivating force to impel person skilled in art to do what applicant has done". Simply, Ex parte Levengood is clearly stating that the motivation to combine the references must be articulated and in fact there must be evidence which the Examiner can rely on to prove the motivation to combine the references to solve the problem solved by the invention under consideration. Simply, none of the refers teach, infer or even remotely imply the cleaning wipe of the instant invention. There is no evidence of motivation in any of the references to accomplish this.

Blanvalet et al fails to teach, imply or infer the solution to the problem as solved by the instant invention - namely, the impregnation of a substrate to form the wipe. 35 U.S.C. 103(a) requires the inference from the primary reference. There is no inference in Blanvalet et al to form a wipe.

The three secondary references do not cure the deficiencies of Blanvalet.

There is no inference, suggestion, implication or teaching in the primary reference or any of the three secondary references to use any of the preservatives as specified in new Claim 11.

None of the references teach, infer or imply the water insoluble substrate as specified in new Claim 11. Lloyd composition is an emulsion which is specially excluded from new Claim 11.

Support for this exclusion is set forth in the original specification. Accordingly, these references teach away from the instantly claims Claims; and therefore, cannot be used in a valid 35 U.S.C. 103(a) rejection. Lloyd does not infer or teach the substrate as presently claims.

Smith III et al substrate with a discontinuous pattern does not infer or teach the substrate as set forth in new Claim 11. Again, the technology of Smith III is based upon emulsion technology which again is specifically excluded in new Claim 11. Therefore, Smith III which teaches away from the new Claims 11-17 cannot be used in a valid 35 U.S.C. 103(a) rejection.

Shantz et al does not cure the deficiencies of the previously disclosed references:

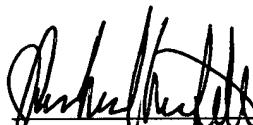
1. This reference does not teach the preservatives as claimed in new Claim 11 nor does it teach the surfactant system of new Claim 11.

2. To infer the instant substrate from Sanchez would be like one trying to open a safe with 100 numbers and not knowing the required combination of only three numbers or even predicting what the weather will be two weeks from the reading of these arguments. Sanchez tells us the fabric can be woven or nonwoven and can be neutral or synthetic fibers, etc. However, does one infer the substrate as set forth in Claim 11 from this broad disclosure and then completely change the surfactant system?

The Examiner has failed to set forth a *prima facie* case of obviousness.

Accordingly, the applicants respectfully request the Examiner to remove his rejections and pass to issuance Claims 11-17.

Respectfully submitted,



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